

REMARKS/ARGUMENTS

The Examiner's Action, mailed February 10, 2004, has been received and reviewed by counsel for Assignee. That Action raised and addressed a number of issues, each of which is discussed separately below using the same section headings as in the Examiner's Action.

Information Disclosure Statement

Accompanying this response is a declaration from John Simons, the inventor. As suggested by the Examiner's comments on the IDS, this declaration sets forth additional facts regarding the invention.

Claim Objections

Claim 2 has been amended to insert the inadvertently omitted word "of."

112 Rejections

Claim 4 has been amended to overcome the §112 rejections noted by the Examiner in paragraphs 9 and 10 of the Action.

102(c) Rejection

The Examiner has rejected all claims under 35 U.S.C. § 102(c) asserting that Applicant has abandoned the application. The Examiner has further stated that the Information Disclosure Statement shows a lack of diligence. The Examiner has also requested information regarding events occurring between 1994 and 2000.

Counsel for Assignee respectfully traverses this rejection. As discussed below and shown in the Declaration, the Applicant has not abandoned the invention. The present application indicates a desire by the inventor to secure patent rights for his employer, the Assignee herein.

The common law is clear that mere delay on the part of the Applicant will not be a bar to seeking a patent on his invention, absent a filing during the period of inactivity by a third party. Furthermore, the accompanying declaration from inventor John Simons explains that the

delay in filing of this application was a result of a lack of appreciation of the usefulness of the invention, as opposed to any intent that it be abandoned. Each of these issues is discussed further below. In addition, as discussed in the section addressing the *Greenbaum* reference (U.S. Patent 5,933,642), it will be apparent that *Greenbaum* did not seek a patent on this same invention prior to Applicant's filing.

There Is No Intent to Abandon

According to the Manual of Patent Examining Procedure, at §2134:

"Actual abandonment under 35 U.S.C. 1.02(c) requires that the inventor intend to abandon the invention, and intent can be implied from the inventor's conduct with respect to the invention. *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971). Such intent to abandon the invention will not be imputed, and every reasonable doubt should be resolved in favor of the inventor.' *Ex parte Dunne*, 20 USPQ2d 1479 (Bd. Pat. App. & Inter. 1991).

* * *

"...Delay alone is not sufficient to infer the requisite intent to abandon. *Moore v. United States*, 194 USPQ 423, 428 (Ct. Cl. 1977)." (Emphasis added.)

As is shown by the inventor's statement, the inventor did not intend to abandon the invention. An appreciation of the usefulness of the invention occurred in 2000, and it was then that this application was filed.

The Common Law

The common law relating to abandonment of an invention is typified by the case of *Paulik, et al. v. Rizkalla, et al.*, 226 USPQ 224 (Fed.Cir. 1985). That case discusses these issues in detail in the context of an interference. There was a four-year delay between Paulik's reduction to practice and his filing date, and after Paulik's filing, Rizkalla filed his patent application. The Board of Appeals held that the four-year delay was fatal. The CAFC, however, vacated the decision. The reasoning of the CAFC was that public policy favored encouraging individuals to file their patent applications, even if delayed. The Court's reasoning is clearly applicable to the situation in this application:

"...There is no impediment in the law to holding that a long period of inactivity need not be a fatal forfeiture, if the first inventor resumes work on the invention before the second inventor enters the

field. We deem this result to be a fairer implementation of national patent policy,... Otherwise, if an inventor were to set an invention aside for 'too long' and later resume work and diligently develop and seek to patent it, according to the Board he would always be worse off than if he never did the early work, even as against a much later entrant.

"Such a restrictive rule would merely add to the burden of those charged with the nation's technological growth. Invention is not a neat process. The value of early work may not be recognized or, for many reasons, it may not become practically useful, until months or years later. Following the Board's decision, any 'too long' delay would constitute a forfeiture fatal in a priority contest, even if terminated by extensive and productive work done long before the newcomer entered the field."

The CAFC supported its opinion with citations to numerous cases cited at 226 USPQ, 226. For example, the court cited *Gallagher v. Smith*, 99 USPQ 132 (CCPA 1953), in which:

"A seven-year delay (from 1938 to 1945) was excused in the absence of evidence of actual concealment or suppression, as against a later applicant who had a reduction to practice in 1943.
Note that the applicant who had delayed was nonetheless first to file." (226 USPQ, at 226, emphasis added.)

The Court distinguished many of the other cases in which delay was held against the inventor as circumstances involving spurring. Typically, in these cases, the first inventor sets aside his work, and then is spurred into filing his patent application as a result of becoming aware of someone else's patent application. Those cases are clearly not applicable here. In the situation here, the Applicant is not attempting to rely upon its earlier reduction to practice of the invention in support of a priority claim to antedate a reference.

The reasoning behind the decision in *Paulik* is discussed in further detail again later in the opinion. The Court notes that it is affirming a long-standing rule that delay between reduction to practice and filing may preclude an inventor from relying upon its reduction to practice in a priority contest, but it will not prevent the inventor from obtaining a patent based on later filing, provided that later filing is still prior to an other party's filing. The court summarized its position:

"We affirm the long-standing rule that too long a delay may bar the first inventor from reliance on an early reduction to practice in a priority contest. But we hold that the first inventor will not be barred from relying on later, resumed activity antedating an opponent's entry into the field, merely because the work done before the delay occurred was sufficient to amount to a reduction to practice." (226 USPQ, at 228, emphasis added.)

Judge Rich in a concurring opinion notes that:

"I merely emphasize that there is no rule of forfeiture from mere lapse of time without activity, nor has there ever been such a rule." (226 USPQ, at 221.)

And later:

"An inventor can delay as long as he likes, in the absence of commercialization, if he is willing to risk having to show in an interference or in facing a defense of prior invention that he has the better right to the patent as between the contesting parties. ...and, finally, there is a question of fairness; why should Paulik be penalized for having done early work if, without reliance on it, he is still ahead of Rizkalla?" (226 USPQ, at 233, citations omitted.)

In a further concurring opinion, Judge Markey notes that it would be draconian if a period of inactivity following a reduction to practice cannot be cured before the earliest date of another. A copy of *Paulik v. Rizkalla* is attached hereto for the Examiner's reference.

Accordingly, counsel submits that the delay in filing this application should not bar the granting of a patent.

102(b) Rejection

In the development of microprocessors and other similar complex systems executing stored instructions, it is sometimes desired to add new instructions to the set of instructions which the microprocessor is to execute. Adding such new instructions, however, creates a problem because the "old" assembler does not "know" the "new" instructions and therefore cannot assemble them into executable code.

The claimed invention of this patent application provides a method of using an old assembler to assemble source code which source code contains both old and new instructions to produce corresponding object code. According to an embodiment of the invention, the source code is first examined by a preprocessor that writes each old instruction to a temporary file unchanged. When a new instruction is encountered in the source code, it is

written to a temporary source file as inserted data representing the object code equivalent of the new instruction. The temporary source file is then applied to the old assembler, which converts the old instructions to their corresponding object code, but passes over the inserted data, leaving the inserted data representing object code for the new instructions. The result is then linked using the existing (old) linker, producing a machine language program that can be executed by the new ISS or the new processor. Thus, all instructions can be executed.

The *Greenbaum* reference (U.S. Patent 5,933,642) teaches a system and method of compiling source code written in C or Pascal to generate executable files for use in a dynamically reconfigurable processing unit which has its changeable internal hardware organization. In one embodiment, the '642 patent encapsulates machine instructions, data, and the hardware configurations required to execute the machine instructions. (See, e.g., col. 3:59-63.)

Greenbaum also describes instructions set architectures that are identified by reconfiguration directives. For example, his compiler 402 generates reconfiguration instructions for specifying an identified instruction set architecture. It then compiles the subset of instructions for execution by that architecture to create assembly language statements which are then assembled to create object files. (Col. 8:45-57.) Thus, counsel's understanding is that *Greenbaum* teaches that assembly language statements for instruction set architectures may be created in the unusual circumstances of a reconfigurable processing unit.

Counsel does not believe, however, that *Greenbaum* teaches the object code enabling execution is generated when instructions, which the assembler cannot convert, are included as well. Thus, counsel does not believe *Greenbaum* teaches that new instructions included in the source code can be copied to a temporary file as data in the form of object code. For these reasons the 102(b) rejection is respectfully traversed.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

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PATENT

Respectfully submitted,



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